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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/003,003	01/05/98	DIETZ M	017096-00021

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GUY W CHAMBERS
TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER 8TH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER	
WHITE,C	
ART UNIT	**PAPER NUMBER**
3713	9

DATE MAILED: 07/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/003,003	DIETZ, MICHAEL J. II	
	Examiner	Art Unit	
	Carmen D. White	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☒ Responsive to communication(s) filed on *08 May 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☐ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other:

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on May 8, 2000 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 5,704,835 has been reviewed and is **NOT** accepted.

The assignee has not established its ownership interest in the patent, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

Non-Statutory Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 20 and 26-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 6-9 of U.S. Patent No. 5,704,835. Although the conflicting claims are not identical, they are

not patentably distinct from each other because the limitation of "a memory which stores ***a list*** of possible symbols to be displayed on said monitor" in claims 20 and 26-30 reads on the limitation of "a memory which stores ***at least one list*** of possible symbols to be displayed on said monitor" in claims 1, 2 and 6-9 of the '835 patent.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabrowski et al in view of Manship et al.

Regarding claim 1, Dabrowski et al discloses a video poker electronic gaming system that includes having a plurality of symbols arrayed in multiple columns; selecting initial card symbols to be arrayed; displaying the initial card symbols selected in an array on the monitor; designating a chosen symbols for replacement; selecting replacement card symbols; replacing the initial card symbols on the monitor with replacement symbols; and determining whether the replacement symbols and any remaining initial symbols constitute a winning combination and rewarding a winning combination (Fig. 1; col. 5, lines 18-28). Dabrowski et al lacks disclosing the card symbols being arrayed in multiple rows. However, in an analogous video gaming machine, Manship et al discloses the arraying of symbols in multiple rows and columns.

It would have been obvious to a person of ordinary skill in the art to arrange the card symbols of the two draw poker card hands of Dabrowski et al in multiple columns and rows, as taught by Manship et al, as a matter of design choice. It is well known in video slot machines to arrange symbols in multiple columns and rows to increase the player's chances of obtaining winning combinations.

Regarding claims 2-9 and 11-17, Dabrowski et al in view of Manship et al discloses all the limitations of the claims as discussed above. Dabrowski further discloses a draw poker gaming system that includes allowing the player to replace card symbols to be replaced by other random card symbols from a stored plurality of card symbols (deck of card symbols). The player has the option to draw and discard card symbols until the player is satisfied with the final group of card symbols (final hand). These are common features of a draw poker gaming system.

Regarding claim 10, Dabrowski et al in view of Manship et al discloses all the limitations of the claims as discussed above. Manship et al further teaches the evaluation of symbols across one or more columns to determine winning combination of symbols (col. 5, lines 13-28 and Fig. 2).

6. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabrowski et al in view of Manship or Bennett (6,056,642).

Regarding claims 18 and 19, Dabrowski et al in view of Manship et al or Bennett disclose all the limitations of the claims as discussed above. Dabrowski et al lacks disclosing the feature of allowing the player to select background colors and replace background colors of symbols. However, Manship or Bennet teach that slot machine

play can be enhanced by changing background colors of symbols. Manship discloses the changing of background colors of the symbols in order to increase the video slot machine's appeal to the player. Bennett also discloses the changing of the background of symbols to increase the payout value of the combination of winning symbols (abstract). It would have been obvious to a person of ordinary skill in the art to incorporate the changing of symbol background color as taught by Manship et al or Bennett in the system of Dabrowski et al in order to enhance the symbol replacement system of Dabrowski et al to further allow the player to increase winning combination outcomes.

7. Claims 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabrowski et al or Heidel et al (5,342,047) in view of Manship et al.

Regarding claims 20-23, 25 and 29-30, Dabrowski et al or Heidel et al discloses an electronic gaming apparatus that includes a monitor for displaying a plurality of symbols arrayed in multiple columns; a memory that stores a list of possible symbols (deck of card symbols); a microprocessor to select symbols from the memory for display on the monitor to determine whether a final group of displayed symbols creates a winning or losing game; a first button to initiate game play and a second button to allow the player to choose replacement symbols for one or more of the initial card symbols and have the microprocessor randomly select replacement card symbols from a list of possible card symbols stored in memory and display the replacement card symbols together with any remaining initial card symbols to create a final group of symbols (hand of cards) [Dabrowski et al- Fig. 1, #62; #60; col. 5, lines 17-28; Heidel et al- Fig. 1; col.

2, lines 51-66)]. Heidel further discloses an embodiment where the video gaming machine can be used to display symbols in multiple rows and columns (Fig. 2a). Dabrowski et al lacks disclosing the card symbols arranged in multiple rows. Manship et al discloses this feature (see above claim rejection for explanation and motivation).

Regarding claims 24 and 26, Dabrowski et al or Heidel et al in view of Manship et al discloses all the limitations of the claims as discussed above. Manship et al further discloses the symbols having the appearance of reels of a slot machine (Fig. 2). Heidel also discloses the display of symbols with the appearance of reels on a slot machine (Fig. 2a).

Regarding claims 27-28, Dabrowski et al or Heidel et al in view of Manship et al discloses all the limitations of the claims as discussed above. Heidel et al further discloses the use of a touch screen controls (abstract; Fig. 1)

Examiner's Response to Applicant's Remarks

8. Applicant argues that the instant invention is not directed to a video poker game. However, the instant claims read on a video poker slot gaming system (see above claim rejections using the Dabrowski et al and Heidel et al references). Examiner has also used the Manship et al reference to teach the arraying of symbols in multiple columns **and** rows.

Applicant should also note that there is a new examiner of record (see below USPTO Contact Information). The Examiner has made a new grounds of rejection of instant claims 1-30 based on the prior art cited above. The above rejection has addressed the features of the amended instant claims.

USPTO Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday-Friday, 8:30 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-308-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

Carmen White
Patent Examiner
July 13, 2000

VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700